<u>REMARKS</u>

In the Office Action, the Examiner rejected claims 1 - 6, 8 - 11, and 22 - 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,006,265 ("Rangan") in view of U.S. Patent Number 5,155,591 ("Wachob"). The Applicant respectfully traverses each of the Examiner's rejections.

The Examiner has stated that all claim limitations were addressed in the Non Final Office Action mailed on May 22, 2006. The Applicant disagrees. The Examiner's communication on May 22, 2006 was an interview summary and nothing more. No rejections were discussed or mentioned in that summary. So, the Examiner must mean that the claim limitations were addressed in the Office Action with a mailing date of January 18, 2006. In that Office Action, the Examiner merely rejected all claims and only addressed claim limitations associated with claims 1 and 22. The Examiner did not even address each independent claim element correctly. That is, the Examiner did not point out where all of the claim elements of claims 1 and 22 are taught.

As an example of where the Examiner failed to address the dependent claims, the Examiner never addressed the broadcasting multimedia information of claim 2, the monitoring of system users of claim 4, the querying of system users of claim 9, the presenting of an interactive component of claim 10, the reading of an IP address of claim 11, the program source of claim 22, or the simultaneous transmission of claim 24. The Applicant challenges the Examiner to find where these claims are individually addressed. The dependent claims are simply lumped together in the rejections of their associated independent claims – without being addressed. The Applicant reminds the Examiner that claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. See M.P.E.P § 707.07(d). Here, they are clearly not because the elements of the dependent claims recite unique features that are not recited in the patentable independent claims. The Examiner should have issued another non final office action to address these claims as the Applicant requested.

Rejections of Claims 1 – 6 and 8 - 11

In claim 1, the Applicant recites a method of transmitting multimedia from a network server information over a data network. The method includes, among other things, receiving

through a screen display demographic information for the at least one system user and using the IP address to access at least one database to retrieve demographic information stored therein associated with the at least one system user. Based on selection of a hypertext link (i.e., by the system user), a multimedia presentation is selected from a computer memory and transmitted to the system user's remotely located computer. The method also includes detecting an inserted commercial break during the transmission of the multimedia presentation and, based on the demographic information, accessing a commercial database and retrieving at least one commercial associated with the demographics for the system user. In this regard, the method also includes transmitting the retrieved commercial to the at least one system user during the commercial break.

The Examiner states that Rangan, at column 20, lines 52 – 60, teaches the steps of receiving through a screen display demographic information for the system user and using the IP address to access a database and retrieve demographic information that is associated with the system user. Here, Rangan merely states that a client subscriber/user/viewer (SUV) may click to a hyper video commercial to initiate a Web transaction (column 20, lines 49 and 50 of Rangan) and that the feedback from the transaction results in on-the-fly commercial insertion that may be tuned to local demographic conditions and user profiles. Nowhere does Rangan state that demographic information for the at least one system user is received through a screen display. In fact, Rangan does not mention or even suggest a screen display for entering demographic information in any form anywhere.

Such a display allows the user to enter demographic information such that preferable commercials may be inserted into the multimedia presentation, which is not contemplated by Rangan. For example, the demographic information of the Applicant's claims originates from system users who have logged on and provided certain demographic information about themselves. This information is stored within a database which allows the programmer to ascertain a particular audience according to the demographic information and subsequently select commercials that are based on that demographic information. *See e.g.*, page 9, lines 5 - 24, page 10, lines 1 - 19 of the Applicant's specification. Rangan, rather, teaches the automatic analysis of streaming video and the insertion of hotspots over hyperlinks to make hypervideo. Column 17, lines 49-53 of Rangan. While Rangan is certainly a challenging reference to

comprehend, the Applicant finds no teaching or reasonable suggestion regarding the entrance of demographic information through a screen display as the Applicant both claims and teaches.

Regardless, Rangan's mere statement of commercial insertion in column 20, line 55 is not the same as the commercial transmission of a retrieved commercial during a commercial break. Rather, Rangan's alleged teaching of a commercial insertion generally regards insertion of hypertext links within video content to make "hypervideo", which allows a user to select additional video content during presentation of the hypervideo. For example, Rangan explicitly states that "in accordance with the present invention, the insertion is not of clips… but rather of hyperlinks", column 20, lines 15 - 22. The specification of Rangan is fraught with explicit references stating that insertion is in the context of hyperlinks that are associated with commercials. *See e.g.*, column 18, lines 51 – 59. This differs from the Applicant's claims because, among other reasons, the Applicant claims the insertion of commercials based on demographic information as opposed to the insertion of hyperlinks and at detected commercial breaks.

The Examiner has cited *In re Keller*, 642 F.2d 413, 208 (C.C.P.A. Feb. 1981) stating that the Applicant argues against the references individually and that one cannot show obviousness by attacking references individually where the rejections are based on combinations of references. The Applicant has thoroughly reviewed *In re Keller* and its progeny. While the Examiner's quote from *In re Keller* is accurate, the Examiner's understanding of *In re Keller* is fundamentally wrong. *In re Keller* represents an Applicant's arguments in favor of patentability based on an obviousness rejection (i.e., § 103(a)) a combination of references, as in the present application. However, in *In re Keller*, the Applicants stipulated that every element of the Applicant's claims were taught by the combined references. The Applicants there, instead, chose to argue that the cited references were not combinable because they were not analogous. For example, in *In re Keller*, the Applicant argued a secondary reference, which included one claim element (i.e., a digital timing circuit) within a teaching of mammalian heart stimulation was not combinable with a primary reference which included all of the Applicant's claim elements except for a digital timing circuit within a teaching of cardiac pacing. However, in *In re Keller*, the Applicant still claimed an analog timing circuit that was easily replaceable with the digital timing circuit of the secondary reference. This differs from the present case because the Applicant here is only stating additional features that the primary reference does not teach.

Summarizing, the Applicant can indeed "attack" a reference when cited references do not teach all of the Applicant's claim elements. For example, the Examiner has stated that Rangan teaches the Applicant's element of receiving through a screen display demographic information for the system user and using the IP address to access a database and retrieve demographic information that is associated with the system user. The Applicant pointed out that Rangan does no such thing. Rangan does not teach receiving demographic information through a screen. The Applicant then pointed out what one skilled in the art would understand Rangan to be teaching, to illustrate the differences between what the Examiner asserts and what the Applicant claims. The Applicant reminds the Examiner that "all elements of the claim must be found in the reference". *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). *See also*, M.P.E.P. § 2143.03. All the Applicant has shown is that Rangan does not teach the Applicant's claim elements as the Examiner suggests.

In any case, the Examiner states that Rangan does not specifically teach detecting a commercial break but that Wachob does. The Applicant agrees that Rangan does not teach detecting a commercial break; but the Applicant respectfully disagrees that Wachob does so. For example, the Examiner points to Figure 3 of Wachob to state that Wachob teaches detecting a commercial break. In Figure 3, Wachob teaches reading tag information that is transmitted by the system head (box 150). "The tag information defines if and when a commercial is about to occur, how long it will last, and which channel the converter should tune to". Column 7, lines 13-21 of Wachob. Again, nothing in this reference suggests detection; rather, the information is provided by the headend.

Regardless, Wachob is not analogous art. For example, Rangan teaches selection of hypertext links within video content for distribution over the Internet. Wachob teaches commercial insertion during predetermined times via cable television (*see e.g.*, column 4, lines 30-35 of Wachob). The Applicant respectfully disagrees because among other reasons, the types of content are totally different. Rangan delivers audio and/or video content digitally via Internet protocols through an Internet network (*see e.g.*, Figure 1 and column 24, lines 32 - 51 of Rangan). Wachob delivers audio and/or video content in an analog fashion via radio frequency AM or FM modulation schemes (*see e.g.*, Figure 1 and column 4, lines 56 - 68 and column 1 – 7 of Wachob). Such analysis is inconsistent with the reasonableness standard stated in *In re Oetiker*, 977 F.2d 1443, 1447 (C.A.Fed.,1992) (stating "it is necessary to consider the reality of

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the circumstances... -in other words, *common sense* - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. See also MPEP § 2141.01(a).

Even if the two references were analogous art, there is simply no motivation to combine. For example, Wachob is specifically related to delivering content to a cable television user via the converter (a.k.a. a set-top-box) of Figure 1 used in conjunction with the remote control of Figure 2. Rangan does not teach or reasonably suggest the use of such boxes because all of Rangan's communications are performed via computers through the Internet. Additionally, there has to be some reasonable expectation of success in the combination. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). *See also* M.P.E.P. § 2143.02. Reasonableness aside, there is simply no way to combine Rangan and Wachob and expect the combination to work because Rangan is directed to the Internet and Wachob is directed to conventional television – two vastly different forms of communication. Such is even illustrated by Rangan when Rangan explicitly states, at column 29, lines 39 – 42, that Rangan's teachings are "in marked contrast to conventional broadcast television where there is no interactivity with the viewer and/or the viewers video playback, especially including commercials."

In any case, since neither Rangan nor Wachob teach or reasonably suggest all of the Applicant's claim elements (e.g., display screens for demographic information entrance) either alone or in combination, Rangan and Wachob are insufficient as references under the "all elements" rule espoused in *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580 (CCPA 1974). The Applicant, therefore, maintains that claim 1 is novel and non obvious in view of the cited references.

Claims 2 - 6 and 8 – 11 depend from claim 1 and inherit all of the novel and non obvious features of the independent claim and are, therefore, novel and non obvious for at least the same reasons as claim 1. However, these claims recite additional features that further distinguish from the independent claim. For example, in claim 4, the Applicant recites a step of monitoring the at least one system user receiving the multimedia presentation and accumulating demographic information. Rangan does not teach monitoring a system user's computer to accumulate demographic information. As stated previously, Rangan in fact explicitly teaches away from the Applicant's claim when Rangan states "This knowledge is not gained by any sort of insidious monitoring of the Client SUVs. Instead, it should be recognized that the Client SUVs from time

to time identify, and link, to the (hyper)video that each wishes to view." Column 18, lines 7 – 11. The Examiner states that Rangan does teach monitoring a system users computer to a cumulative demographic information at column and row 29, lines 35 through 39. Here, Rangan states that an advertiser may develop statistics on "click-throughs". A click-through, as is known to those skilled in the art, is obtained from users who "click" on a web page. Such is analogous to monitoring your own website to determine how many other people "click" on your website. This, however, does not constitute monitoring another person's computer as the Applicant claims and which again Rangan explicitly does not do. For at least these reasons, claim 4 is novel and nonobvious in view of the cited references. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 4.

As another example, claim 5 recites a step of detecting a commercial break being performed for ad hoc commercial breaks. As Examiner has pointed out, Rangan does not teach detecting a commercial break let alone an ad hoc commercial break. An ad hoc commercial break of the Applicant's claims is a type of commercial which may be shown during a program which has a number of nondesignated commercial breaks. Examples of such include sporting events having commercials being shown during unpredictable timeouts. Page 10, lines 15 – 19 of the present application. The Applicant has already shown that Wachob does not teach detection of a commercial break. As such, Wachob cannot teach detection of an ad hoc commercial break. In fact, Wachob has no teaching or reasonable suggestion regarding any type of unpredictable commercial break detection. Since Rangan does not, claim 5 must be novel and nonobvious in view of the cited references. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 5.

In yet another example of reasons for patentability, claim 9 recites a step of querying the at least one system user to provide the demographic information when the at least one system user logs on to the network server. Neither Rangan nor Wachob teach or reasonably suggest querying a user for demographic information when the at least one system user logs on to the network server. For example, Rangan only states that demographic information is used; but, Rangan makes no reference as to how the information is acquired. Wachob, on the other hand, states that information is provided by means of a remote control or "household survey". Column 1, lines 48 – 64 of Wachob. But, Wachob does not teach or reasonably suggest any type of querying of a system user being performed by the network, particularly when the system user

logs on to the network. The Examiner states that the Applicant's claimed querying is done when the user inputs demographic data. This is not querying. Querying a system user involves making an inquiry to the user. Wachob's system does no such thing; Wachob's users input data to a system without regard to any query. The Examiner has a fundamental misunderstanding between that which is taught and that which the Applicant claims. Since Rangan and Wachob neither teach nor reasonably suggest querying of the system user for demographic information when the system user logs on, the cited references are simply insufficient in nullifying the patentable features of the Applicant's claim. For at least these reasons, claim 9 is allowable in view of the cited references. The Applicant, therefore, respectfully requests reconsideration and allowance of claim 9.

Another example of patentable distinction is illustrated in claim 11. In claim 11, the Applicant recites a step of receiving a login ID from the at least one system user upon logging into the network server. Nowhere does Rangan or Wachob teach or reasonably suggest receiving a login ID from a system user, either alone or in combination. In fact, the Applicant maintains that Wachob is essentially precluded from doing so because, among other reasons, the non-analogous art of Wachob is directed towards cable television and not the network servers associated with the Internet of the Applicant's claims (e.g., cable television users do not log on to their set top boxes, now or in the past). The Examiner finally addresses this claim and now argues that Rangan teaches a login but the Examiner does not show where. The Examiner's statement is nothing more than a bald assertion. The Applicant has made a thorough search of Rangan and finds no such teaching. In fact, Rangan does not use any form of the word "log". Since neither Rangan nor Wachob teach or reasonably suggest receiving a login ID as the Applicant claims, claim 11 is novel and nonobvious in view of these references. The Applicant, therefore, respectfully requests reconsideration and allowance of claim number 11.

Rejections of Claims 22 – 25

In claim 22, the Applicant recites a network server configured for transmitting multimedia information over a data network. The network server includes a schedule database that stores one or more schedules for the multimedia information as well as one or more screen displays which are presentable and through which the system users enter demographic information. The system also includes a program source from which the multimedia information

may be retrieved and a commercial database that stores commercials that are transmittable to at least one system user and that are associated with one or more types of demographic information. The network server also includes a processor that selects one or more commercials associated with the demographic information entered by the system users and transmits those selected commercials with selected multimedia information.

The Examiner rejects claim 22 based on official notice because, as the Examiner states, it is old and well known "to schedule when certain information is to be scheduled in order to designate a fixed time for an event". Assuming for the sake of argument that the Examiner is correct, the Examiner has still failed to address where a schedule database stores one or more screen displays which are presentable and through which the system users enter demographic information. The Applicant maintains that neither Rangan nor Machob teach or reasonably suggest such storage. Accordingly, the Applicant believes claim 22 is allowable and respectfully requests such disposition.

In regards to the Examiner's official notice, it should be noted that the Examiner cannot simply pick and choose elements to deprecate the claimed invention as such would be hindsight. *See e.g., In re Fine*, 837 F.2d 1071, 1075 (C.A.Fed., 1988); *see also*, M.P.E.P. § 2143.03. The Applicant maintains that storing screen displays within a schedule database is not well-known or old. The Applicant again demands proof of such an assertion. The Examiner stated, however, that the Applicant did not properly challenge the Examiner's official notice and cited "*In re Boon*" at M.P.E.P. § 2144.03. There is no such citation at M.P.E.P. § 2144.03. Regardless, to adequately traverse "Official Notice", an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. M.P.E.P. § 2144.03. Therefore, to clarify, databases are known to store data. A scheduling database, if it is even known at all, would be used to store data pertaining to scheduling. Storing screen display data in a scheduling database would essentially be storing data other than what it was originally configured for. Accordingly, the Applicant maintains that storing screen displays within a schedule database is not well-known or old and again demands proof of such an assertion.

CONCLUSION

The Applicant pointed out the Examiner's failure to address each claim in the previous Office Action and requested a new Non Final Office Action. The Examiner completely dismissed the Applicant's statements in the present Final Office Action. In the event that the Examiner again deems the Applicant's remarks unpersuasive, the Applicant respectfully requests a prompt response so that the Applicant may better address these appealable issues.

Based upon the foregoing, the Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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